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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,596	08/06/2008	Joachim Simon	CH-8467/LeA 36,906	1662

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EXAMINER
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SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1765

MAIL DATE	DELIVERY MODE
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02/16/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,596	<b>Applicant(s)</b> SIMON ET AL.	
	<b>Examiner</b> Rabon Sergent	<b>Art Unit</b> 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/13/2007</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

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1. Claim 5 provides for the use of the tolylene-diisocyanate-based isocyanurate polyisocyanate solutions according to claim 4, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps that yield an isocyanurate. With respect to independent claims 2 and 3, applicants have failed to set forth any definitive process steps that would yield the isocyanurate. It appears that these claims should actually depend from claim 1.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the language, “tolylene-diisocyanate-based”, renders the claims indefinite, because it is unclear to what extent the solutions are “based” on or derived from tolylene diisocyanate.

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Secondly, with respect to C) of claim 1, the use of the word, “type”, so extends the scope of the term with which it is associated that it renders the term indefinite. *Ex parte Copenhaver*, 109 USPQ 118.

Thirdly, with respect to D) of claim 1, the use of the word, "rigorous", renders the claims indefinite, because the language is subjective. It cannot be determined how "rigorous absence" differs from "absence".

Fourthly, with respect to D) of claim 1, it is unclear if “aliphatic” also pertains to the claimed urethane groups.

Fifthly, applicants have failed to clearly specify bases for the claimed weight percents associated with the TDI isomer mixtures and residual TDI monomers.

Sixthly, with respect to claim 2, it is unclear what compounds are encompassed by “the isomeric diisononyl phthalates”. Also, this language and reference to “A)” lack antecedent basis.

Seventhly, with respect to claim 3, the language, “the 2,6-TDI content of the tolylene diisocyanate mixtures used in component B)”, lacks antecedent basis.

Eighthly, with respect to claims 4 and 6, the use of the word, “obtainable”, renders the claims indefinite, because it cannot be determined when the solutions can be obtained by the claimed method and when they cannot be obtained by the claimed method.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Breidenbach et al. ('729).

Breidenbach et al. disclose the use of isocyanurate solutions derived from toluene diisocyanate and containing plasticizers, as solvents, as adhesion improvers within PVC coatings, wherein the use of TDI isomer mixtures having 80 percent by weight of the 2,4-TDI isomer are preferred. Furthermore, applicants disclose the preferred use of dioctyl phthalate as the plasticizer/solvent, which correspond to applicants' claimed dialkyl phthalate component, and catalysts which correspond to applicants' claimed catalysts. See abstract; column 3, lines 9-14 and 42+; column 4; column 5, lines 5-24; column 6, line 65; and Examples 9, 11, and 14. Applicants' claimed residual TDI monomer contents and viscosities are disclosed within the aforementioned examples. Furthermore, given that patentees employ applicants' claimed

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components and processing method and given the fact that the disclosed solutions and the instant solution are used for the same purpose, the position is taken that the claimed solids content is an inherent feature of the disclosed solutions. Still, even if not inherently possessed, the position is taken that it would have been obvious to formulate the solutions having the claimed solids content, since the claimed content is within the range disclosed by patentees within column 5, lines 18-24.

6. A rejection under 35 USC 102 as being anticipated or alternatively under 35 USC 103(a) is proper when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breidenbach et al. ('729).

As aforementioned, Breidenbach et al. disclose the use of isocyanurate solutions derived from toluene diisocyanate and containing plasticizers, as solvents, as adhesion improvers within PVC coatings, wherein the use of TDI isomer mixtures having 80 percent by weight of the 2,4-TDI isomer are preferred. Furthermore, applicants disclose plasticizers derived from aromatic dicarboxylic acids and branched aliphatic alcohols, wherein the preferred use of dioctyl phthalate as the plasticizer/solvent is further disclosed. Also, patentees disclose catalysts which correspond to applicants' claimed catalysts. See abstract; column 3, lines 9-14 and 42+; column 4; column 5, lines 5-24; column 6, line 65; and Examples 9, 11, and 14. Applicants' claimed

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residual TDI monomer contents and viscosities are disclosed within the aforementioned examples. Furthermore, patentees disclose a range of solids contents that encompass that claimed by applicants; therefore, it would have been obvious to practice the invention using the claimed solids content.

8. Though patentees fail to specifically disclose the use of diisononyl phthalates as the plasticizer/solvent, the position is taken that their use would have been *prima facie* obvious, since they are encompassed by the description of suitable plasticizers and since they are structurally similar to the preferred dioctyl phthalates to such an extent that the skilled artisan would have reasonably expected them to have similar properties and therefore be functionally equivalent. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09 (I).

9. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 10229780 A1 (English language equivalent: US 6,936,678 B2) or Brahm et al. (US 2004/0006228 A1), each in view of Breidenbach et al. ('729).

Each of the primary references discloses the production of low TDI monomer containing isocyanurates, wherein TDI containing 80 percent of the 2,4-TDI isomer is reacted in the presence of a solvent and a Mannich catalyst to produce an isocyanurate product having applicants' claimed free TDI monomer content, viscosity, and solids content. See Examples 1 and 2 within each reference. Though the solvent of the examples is not a dialkyl phthalate, it is disclosed within each reference that plasticizers such as phthalates may be utilized. See column 3, line 55 within US 6,936,678 B2 and paragraph [0028] within Brahm et al.

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10. Though each of the primary references discloses that phthalate plasticizers may be used as the solvent, these references fail to disclose applicants' claimed dialkyl phthalate. Still, the use of dialkyl phthalates that correspond to those of applicants as solvents for TDI derived isocyanurates, to be used within PVC coating compositions, was known at the time of invention. This position is supported by the teachings of Breidenbach et al. within column 3, lines 42+ and the examples, wherein dioctyl phthalate is specifically recited. Therefore, in accordance with the aforementioned teachings within the primary references, the position is taken that it would have been obvious to utilize the instantly claimed solvents within the methods of the primary references so as to arrive at the instant invention.

11. With respect to claim 2, though Breidenbach et al. fail to specifically disclose the use of diisononyl phthalates as the plasticizer/solvent, the position is taken that their use would have been prima facie obvious, since they are encompassed by the description of suitable plasticizers within Breidenbach et al. and since they are structurally similar to the preferred (exemplified) dioctyl phthalates to such an extent that the skilled artisan would have reasonably expected them to have similar properties and therefore be functionally equivalent. In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See MPEP 2144.09 (I).

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/  
Primary Examiner, Art Unit 1765